

REMARKS

Claims 1 – 9, 11 – 20, and 24 – 26 were pending.

Rejection Of Claim 1 Under 35 U.S.C. § 112, ¶ 1, Statutory Subject Matter

Although the Applicant disagrees with the Office Action in its allegation that the preamble of Claim 1 does not cause Claim 1 to fall into a statutory class of subject matter, in an effort to progress the prosecution of the present application, the Applicant has amended Claim 1 to define clearly statutory subject matter.

Rejection Of Claims 1, 15, 24 Under 35 U.S.C. § 112, ¶ 1, Written Description

The Office Action rejected Claims 1, 15, and 24 under 35 U.S.C. § 112, ¶ 1, as allegedly failing to comply with the written description requirement. To the best of the Applicant's understanding of the Office Action, the Office Action asserted that the specification as originally filed appears to not have support for the advertisement being "generally positioned" with respect to the web browser, that the consumer selectable "options generally are hidden from the consumer," that the consumer mouses over the symbol, and that the advertisement and the options can be shown at the same time. The Applicant notes that the Examiner listed Claims 1, 15, and 24, yet provides citations for Claims 1, 24, and 26. In any event, the foregoing claims terms are clearly part of the written description of the application.

M.P.E.P. § 2163 comments on the written description requirement as follows:

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. . . . The issue raised in [many] cases is most often phrased as whether the original application provides 'adequate support' for the claims at issue or whether the material . . . incorporates 'new matter' in violation of 35 U.S.C. [§] 132. . . . While there is no [word-for-word] requirement, newly added claim limitations must be supported in the spec through express, implicit or inherent disclosure.

The Applicant respectfully submits that the claim terms referenced above are supported by the originally filed specification as follows.

Figure 8 shows a generally positioned banner advertisement and Figure 9 shows the previously hidden consumer selections once the advertisement is moused over by the consumer. The following excerpts are from the present specification.



FIG. 8

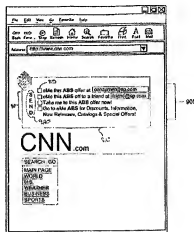


FIG. 9

[0109] According to one embodiment, the advertisement 810 comprises a banner advertisement, which can also be presented in a wide number of shapes and sizes, can be positioned virtually anywhere on the web page 800, or animated on or throughout the same. The advertisement 810 can "float" on the web page 800 such that as the consumer scrolls through the electronic content 805, the advertisement 810, for example, remains in a position viewable on the web page 800. Additionally, the advertisement 810 may appear in a pop up, consistent or semi-consistent window, toolbar or the like. As shown in FIG. 8, the exemplary banner advertisement 810 is shaped similar to a rectangular "banner" anchored to a section of the web page 800.

[0110] According to one embodiment, the advertisement 810 includes ad space 815 and identifying indicia 820. As known to one of skill in the art, the ad space 815 can include various types of multimedia information, including simple text, images, animation, sound, embedded executable code or scripts, static or dynamic displays, or the like, which promote products, services, websites, or the like. Generally, the content and/or code for the ad space 815 is produced and sold by business entities other than the website provider. For example, the code that generates the content of the ad space 815 can include links that pull content from web servers connected through the communications network 125 while the

website provider in the illustrated FIGURE can be CNN.com As shown in FIG. 8, the ad space 815 comprises simple text related to a promotion for getting the consumer 130 in better physical shape.

[0111] The identifying indicia 820 alerts consumers that the advertisement 810 includes feature rich functionality. In one embodiment, the identifying indicia 820 is placed on or near the banner. The identifying indicia 820 can include a mark, an interactive symbol, or the like. According to a preferred embodiment, the identifying indicia 820 comprises cube 825. According to another preferred embodiment, the identifying indicia 820 comprises an animated cube, such as, for example, spinning cube 825 made of the letter "E," identifying eMe, Inc. as the provider of the advertisement 810.

[0112] According to one embodiment, the advertisement 810 includes a mechanism for activating some or all of the features of the feature rich advertisement 810. According to one embodiment, embedded code recognizes when the consumer 130 moves his or her cursor on the consumer computing device 105 over the advertisement 810 ("mouses-over"). However, a software programmer will recognize a number of consumer actions that can be used to activate the advertisement 810, including, for example, selection of the identifying indicia, or the like.

[0113] FIG. 9 illustrates the exemplary web page 800 after the feature rich advertisement 810 has been activated, according to aspects of an embodiment of the invention. As shown in FIG. 9, the advertisement 810 includes a number of request options 905, selectable by the consumer using selection mechanisms 910. The request options 905 can advantageously include a request for an e-mail of the advertisement, a request for an e-mail of the advertisement to be sent to one or more other e-mail addresses, redirection of the consumer's browser, a new window in the browser, or the like, to additional information related to the promotional offer in the advertisement 810, or redirection of the same to, for example, other consumer information related to the subject matter of the advertisement, such as, for example, discounts, information, new releases, catalogs, special offers, or the like.

[0114] According to a preferred embodiment, the first and second request options allow the consumer to request an e-mail of the promotion be sent to his or her e-mail address, e-mail addresses of his or her friends or acquaintances or the like, or both. As shown in FIG. 9, the first request option can include a text box allowing the consumer to enter his or her preferred e-mail address. Additionally, the second request option can include one or more text boxes allowing the consumer to enter one or

more e-mail addresses of his or her friends, or acquaintances. As will be discussed with reference to FIG. 10, the foregoing addresses may automatically loaded into the foregoing text boxes for consumer editing or acceptance. . . .

[0118] FIG. 9 also shows the request options be selectable through the selection mechanisms 910, such as, for example, checkboxes 915 and a submit button 920. Use of checkboxes advantageously allows the consumer 130 to select multiple request options before submitting the selections to the marketing system 120. However, a skilled artisan will recognize from the disclosure herein a wide variety of possible selection mechanisms, including hypertext, interactive buttons, pull-down menus, text boxes, or the like.

[0119] Based on the foregoing, the feature rich advertisement 810 advantageously allows a consumer to request specific information related to a promotional offer. By allowing for consumer selection, the advertisers advantageously target their information and the advertisement providers can advantageously generate revenue from the targeted advertising.

[0120] Although the advertisement 810 is disclosed with reference to its preferred embodiment where the advertisement is activated by the consumer, the invention is not intended to be limited thereby. Rather, an artisan will recognize from the disclosure herein a wide number of alternatives for the advertisement 810. For example, the feature rich advertisement 810 may advantageously show the ad space 815 and the request options 905 at the same time, thereby avoiding the need for consumer activation. Additionally, the advertisement 810 may be other than a banner advertisement.

Based on at least the foregoing examples, the Applicant submits that the claim elements referenced by the Examiner are fully supported and described by the present specification.

Rejection Of Claims 1 and 15 Under 35 U.S.C. § 112, ¶ 2, Indefiniteness

The Office Action rejected Claims 1 and 15, and 24 under 35 U.S.C. § 112, ¶ 2, for alleged indefiniteness; however, as shown above, the Applicant submits that such terms are simply not indefinite to an artisan in the online advertising industry from the disclosure herein, especially from the disclosure specifically referenced.

Rejection Of the Claims Under 35 U.S.C. § 103

The Office Action rejected Claims 1 – 9, 11 – 20, and 24 – 26 under 35 U.S.C. § 103 as being unpatentable over U.S. patent no. 5,960,409, issued to Wexler. The Applicant notes this rejection was already issued in this case, subsequently withdrawn, and has reappeared. Similar to the comments made in prior responses, the Applicant respectfully traverses this rejection because the Wexler fails to teach or suggest the elements of the claims. See M.P.E.P. § 2143 (stating that in order to establish a *prima facie* case of obviousness for a claim, the prior art references must teach or suggest all the claim limitations).

Wexler teaches simply redirection of a consumer who clicks on a prior art banner advertisement to a click-count company. The click-count company records statistical information, and then redirects again the user to the website of the advertiser. For example, Wexler col. 4:38:

If the user is interested in more information about the banner 9, he may click on it. According to the present invention, the banner 9 points to the third party Web site 13 rather than the advertiser's Web site 17 as in conventional arrangements. As such, in a system according to the present invention, clicking on the banner 9 establishes a link between the user's Web browser 3 and the third party Web site 13. This is facilitated by the operation described in operation block 101 of the flow diagram of FIG. 3, which is an exemplary method according to the present invention. According to operation block 101, the hypertext file that generates the Web page 7 and the banner 9 is edited or originally coded so that the banner 9 is operable, in conjunction with the user's Web browser 3, to form a hypertext link to the third party Web site 13 when clicked upon. The aforementioned coding includes the URL pointing to the third party site 13.

If a user clicks on the banner 9 forming a link to the third party, then, as indicated in operation block 103 of FIG. 3, the third party accounting and statistical service 13 receives a download request signal 15a from the user's Web browser 3. **The third party service 13 accepts the download request signal 15a and increments a counter that keeps track of the number of received request signals, as indicated in operation block 105.** Additionally, the third party service 13 logs a variety of information available from the user's Web browser 3. Such information can include the origin of the user, the address of the banner publisher, and so forth. In this manner, the third party service 13 accumulates statistical information useful to the banner publisher and the advertiser.

The download request received by the third party service 13 is ultimately intended to obtain information from the advertiser. As such, the third party service 13 redirects the received download request signal to the advertiser's Web site 17, as indicated in operation block 107. Specifically, the redirect request 15b is sent to the user's Web browser 3 from the third party Web site 13, and, from the browser, a download request 19a is sent to the advertiser's Web site 17. Once the download request signal is received by the advertiser, the advertiser's Web page is downloaded to the user's Web browser 3 as indicated by reference numeral 11b. The method is transparent from the user's point of view; he is not aware of the "detour" to the third party service 13.

In contrast to Wexler's system of redirecting user banner clicks to one website for statistics and then the advertiser's website, the present claims specifically recite user interaction with a novel and non-obvious banner advertisement. For example, independent Claims 1 and 15 recite:

1. A feature rich advertisement . . . comprising:

a consumer computer displaying an advertisement . . . ;

the consumer computer configured to display a plurality of consumer-selectable request options associated with said one or more promotions, said consumer-selectable request options generally hidden from said consumer on said browser, wherein when at least one of said request options is selected by said consumer, the at least one request option is configured to deliver information associated with the one or more promotions via e-mail to an e-mail address entered or confirmed by the consumer; and

the consumer computer additionally displaying visible identifying indicia associated generally with respect to said advertisement in said browser identifying for said consumer that said advertisement comprises a feature rich advertisement, wherein upon activation of said advertisement by said consumer, one or more of the consumer-selectable request options are unhidden and become visible.

15. A method . . . comprising:

transferring data to a consumer computing device causing a browser program executing on said device to display an advertisement including promotional information, said advertisement including one or more interactive symbols associated with said advertisement identifying said advertisement as a feature rich advertisement including consumer-selectable requests for additional promotional information, the requests being initially generally hidden from view but becoming visible when a consumer viewing said advertisement activates said advertisement;

receiving from said consumer computing device a consumer selected request for information related to the promotional information, the consumer selected request designating at least one e-mail address; and sending the information to the at least one e-mail address via e-mail.

Wexler utterly fails to teach or suggest at least the foregoing claim elements. Moreover, this is at least partially admitted by the Office Action under "Official Notice." The Applicant traverses the notice as the notice asserts that an artisan would incorporate Wexler with official notice of virtually the entirety of the claim limitations. The notice attempts support at least the sending of emails by citing to common uses of email. Such hindsight analysis and wave-of-hand "Office Notice" is entirely inappropriate. The Applicant has claimed a specific interactive banner advertisement that allows consumers to request email notifications of additional information and to dictate how that information will be provided. This feature-rich advertisement is not shown, taught or suggested by any of the art of record, especially not by Wexler.

Based on the foregoing, the Applicant respectfully requests withdrawal of the rejections of independent Claims 1 and 15. Moreover, the Applicant notes that claims 2 – 9, 11 – 14, 16 – 20, and 24 – 26; dependent from Claims 1 and 15, and based on the dependency and the additional features recited therein, the Applicant respectfully requests withdrawal of rejections of those claims as well.

Discussions with Supervisor James Myhre

The Applicant and Supervisor Myhre discussed today various issues the Applicant has with the progress of the examination to date. A 2nd Office Action was issued that was of such quality that former Supervisor Eric Stamber agreed to withdraw it as inappropriate. Director Coggins needed to intervene to avoid the Examiner unintentionally abandoning the application. The day after the withdrawal, the present Office Action issued with a prior art rejection essentially copied from an earlier Office Action in the file history. The Applicant requests that Examiner Janvier together with Supervisor Myhre and/or Director Coggins call the undersigned before any additional Office Action is issued in the present application.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 25, 2009

By: 

John M. Grover
Registration No. 42,610
Attorney of Record
Customer No.
(949) 760-0404

AMEND
6872145
032509